

Customer No.: 31561
Application No.: 10/605,421
Docket No.: 11096-US-PA

REMARKS

Discussion of Office Action Rejections

The Office Action rejected claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (Fig. 1, sections [0005]-[0007]), hereafter "AAPA", in view of Huang (US 2003/0177345).

Responsive to the rejections thereto, Applicants hereby otherwise traverse the rejections. As such, Applicants submit that the present invention, as set forth in claims 1-5, is neither taught, disclosed, nor suggested by AAPA, Huang, or any of the other cited references, taken alone or in combination, and thus should be allowed.

With respect to claim 1, as amended, recites:

A keyboard controller (KBC) updating process in a computer system, comprising the steps of:

preparing a basic input/output system (BIOS) flash utility, a KBC flash utility, a BIOS data and a KBC data in the system; and
updating the KBC data during a power-on self-test (POST) of the system. (Emphasis added)

Applicant submits that such a KBC updating process, as set forth in claim 1 is neither taught, disclosed, nor suggested by AAPA, Huang or any of the other cited references, taken alone or in combination.

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First of all, Applicants submit that neither AAPA, nor Huang teaches a step of “updating the KBC data during a power-on self-test (POST) of the system”, that is required by the KBC updating process as set forth in claim 1.

Applicants note that the Examiner had admitted that AAPA does not update the KBC during a power-on self-test (POST) of the system. The Examiner then cited Huang as a second reference to modify AAPA in order to render the present invention *prima facie* obvious. The Examiner contended that “Fig. 3 of Huang teaches a method for updating the KBC during the power on period” (page 2 of the current Office Action). However, even though Huang teaches “a power (AC 110V) is cabled to the notebook computer 200 in advance” (Paragraph [0022]) when discussing Fig. 3, such context is insufficient for teaching the specified claimed limitation, i.e., “updating the KBC data during a power-on self-test (POST) of the system”. Applicants submit that a power on state is common for any electronic device, e.g., a computer system, since only powered on computer systems could be operated. However, Huang is either silent or feel unnecessary to have a power-on self-test (POST) in his disclosure. Accordingly, Applicants submit that the cited references, AAPA and Huang, taken alone or in combination, fails to teach each and every limitation as set forth in claim 1.

Further, Huang teaches a method for updating a BIOS rather than a KBC updating process. Throughout the specification and drawings, Huang discusses nothing about “updating the KBC data” that is required by claim 1. Therefore, no motivations or suggestions to combine AAPA with Huang could be found, either expressly or inherently, in the prior art references.

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Although the Examiner contends that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the KBC process of the admitted prior art to include the KCB updating process as taught by Huang so as to provide KCB updating in the BIOS in order to eliminate one system rebooting operations", such a motivation can only be found in Applicants' own disclosure, rather than AAPA or Huang. See *ACS Hosp. Sys, Inc. v. Montefiore Hosp.*, 732 F. 2d 1572, 221 USPQ 929 (Fed. Cir. 1984).

For at least the foregoing reasons, Applicants submit that claim 1, as originally filed, is novel and unobvious over AAPA, Huang, or any of the other cited references, taken alone or in combination, and thus should be allowed.

Moreover, with respect to claim 2, as originally filed, recites in part:
building a KBC including the KBC data and the KBC flash utility by
using a KBC designing tool;
combining the KBC into the BIOS
... (Emphasis added)

Applicants submit that such a KBC updating process, as set forth in claim 2, is neither taught, suggested, nor disclosed by AAPA, Huang, or any of the other cited references.

Applicants submit that the claimed invention should be taken as a whole, and thus the required step combining the KBC, including the KBC data and the KBC flash utility, into the BIOS has not taught by step 124 in AAPA, as alleged by the Examiner. Step 124 in AAPA recites "flash KBC using KBC flash utility. However, considering the KBC updating process as set forth in claim 2, the KBC flash utility is included in the KBC that is to be combined into the BIOS. Therefore, combining the KBC into the BIOS is distinct from flashing the KBC. As such,

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Applicant submit that claim 2 is novel and unobvious over AAPA, Huang, or any of the other cited references, taken alone or in combination, and thus should be allowed.

If independent claim 1 is allowable over the prior art of record, then its dependent claims 2-5 are allowable as a matter of law, because these dependent claims contain all features of their respective independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

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CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims 1-5 are in proper condition for allowance and an action to such effect is earnestly solicited. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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Respectfully submitted,

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